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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,842	10/16/2003	Ronald M. Rockwell	A2487-US-NP XERZ 2 01279	8491
27885	7590	03/17/2008		
FAY SHARPE LLP 1100 SUPERIOR AVENUE, SEVENTH FLOOR CLEVELAND, OH 44114				
EXAMINER				
POLLACK, MELVIN H				
ART UNIT		PAPER NUMBER		
2145				
MAIL DATE		DELIVERY MODE		
03/17/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/686,842

**Applicant(s)**

ROCKWELL, RONALD M.

**Examiner**

MELVIN H. POLLACK

**Art Unit**

2145

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 6-9, 13-26 and 28-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-9, 13-26 and 28-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☒ Other: see attached office action.

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 1-4, 6-9, 13-26, and 28-38 have been considered but are moot in view of the new ground(s) of rejection.
2. In the response to the last office action, the applicant changed the scope of the claims by adding limitations that the managed device is a printer or related peripheral to all independent claims. The examiner has determined that the change in scope is materially sufficient to necessitate search and consideration of the added limitations and/or clarifications. As a result, a final amendment is necessitated even if the examiner provides a new art rejection. The examiner acknowledges that no new matter has been added by this amendment.
3. The objection to the abstract is withdrawn in light of the amendment. The new abstract is accepted.
4. The 112P2 rejections and minor claim objections have been withdrawn in light of the amendments.
5. In response to applicant's arguments regarding the 101-112P1 rejection (Pp. 11-12), the claims must state a useful, concrete and tangible result, and such result may not be read in from the specification. In light of the amendment to independent claims 1 and 26, the examiner finds that the useful, concrete and tangible result has been added. Therefore, these rejections are withdrawn solely because of review of the claims.
6. Regarding the 101 rejection due to non-statutory subject matter, the applicant argues that claims 1 (and presumably 26) are not software-per-se, but are product/apparatus claims (P. 11).

Examiner presumes that the applicant is trying to form a hardware or hardware-software combination. However, neither claim 1 nor claim 26 fulfill the necessary limitations for such, i.e. any form of hardware. Instead, claim 1 is drawn to a provisioning services platform (software), compiler implemented (software) comprising a software server made up of program modules. Only the monitored object may be considered hardware, and that is not enough. Claim 6 is drawn to an architecture and implementation of the software server, the server comprising nothing except software modules.

7. Applicant may rectify the situation by showing that the software has a hardware component, i.e. that it is stored on computer-readable medium and executed by a processor. In the alternative, the applicant may clarify that the server is hardware based, and comprises more than just software, i.e. a processor.

8. Applicant alleges that the art does not expressly disclose management of printing systems and related non-programmable devices (Pp. 12-13), but rather the management of computers and related programmable devices. Westerinen does teach the application of attached printers and print services (col. 4, lines 10-15; col. 7, lines 5-10). However, for the sake of advancing prosecution, the examiner will modify the original rejection in favor of new art showing this added limitation.

9. Applicant also alleges that Westerinen does not expressly disclose order processing. Westerinen teaches a variety of potential repair options, including the repair of hardware based problems (col. 8, lines 55-65; col. 12, lines 15-40). In particular, it teaches the ordering of a part for upgrading or hot-fixing (col. 13, lines 20-30).

10. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the particular meaning of order processing) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant wishes to narrowly define this item beyond a command to a system or a network administrator to mean a purchase of a component. The claims as currently drawn do not allow for such a narrow interpretation. Nor can one consider "service sponsors" to be narrowly interpreted as a supply sales company as opposed to repair personnel or network administrators.

11. Therefore, the modified rejection is to be considered final in light of the amendment.

***Claim Rejections - 35 USC § 101***

12. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

13. Claims 1-38 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. These claims are mere software per se.

14. In addition, all of claims 1-38 lack a useful, concrete and tangible result. Most of the claims lack even a single functionality step, and are merely structural claims. For example, claims 1 and 2 are merely descriptions of a database. Claim 3 does have functionality, but no tangible result. The claims must be replaced or amended to provide functionality and tangible results.

***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 1-4, 6-9, 13-26 and 28-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Westerinen et al. (7,065,740) in view of Haines et al. (2002/0072998).

17. Westerinen teaches a method and system (abstract) of providing a remote platform for provisioning services (col. 1, line 1 – col. 4, line 5) wherein the model is based on a shared user service lifecycle (col. 4, lines 5-10) that interacts with service customers (col. 4, lines 35) and with developers (col. 4, lines 40 – col. 5, line 10), in a modular structure described in the claim. The system may be local or remote to the user (col. 7, lines 5-40), and includes an order processing module to perform translation and the handling of maintenance and upgrading, based on policy and entity managers (col. 7, line 40 – col. 11, line 3). A registration module performs a check on the identity (col. 11, lines 3-15), and other security features (col. 12, line 23). A service definitions module (col. 11, lines 15-40) assist in monitoring (col. 11, lines 40-55) and in the development, distribution and update of services (col. 12, lines 15-35).

18. Westerinen does not expressly disclose that the clients comprise such devices as a printer or copier, for the purposes of supplies replenishment. Haines teaches a method and system (abstract) of ordering consumables (Paras. 1-24 and 103-104) wherein a printer connected to a network (Paras. 25-35) is monitored and managed (Paras. 36-50) for automatic reordering (Paras. 73-78). At the time the invention was made, one of ordinary skill in the art would have added Haines in order to increase efficiency in maintenance tasks (Para. 6).

*Conclusion*

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. They regard further teachings on printer supply reordering and on remote maintenance of clients.

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELVIN H. POLLACK whose telephone number is (571)272-3887. The examiner can normally be reached on 8:00-4:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on (571) 272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. H. P./  
Examiner, Art Unit 2145  
07 March 2008

/Jason D Cardone/  
Supervisory Patent Examiner, Art Unit 2145